REMARKS/ARGUMENT

Status Of The Claims

Per the Applicants' election (with traverse) of Group I, Claims 36-39 have been canceled without prejudice. Claim 11 has also been canceled without prejudice. Claims 1, 8, 43, and 44 have been amended to incorporate the language of cancelled claim 11, and the formula for calculating reserve alkalinity of the composition (for basis see page 4, lines 14-24) or to require the use "for removing cooked-, baked-, or burnt-on acidic food soil from cookware and tableware," as is described in Claim 1. These amendments are being entered to bring the claims into conformance with, inter alia, 37 CFR 1.75. Claims 1-10, 12-35 and 41-44 are now pending in this application.

Election/Restriction Requirement

Paramount to issuing a restriction requirement, the Manual of Patent Examining Procedure ("MPEP") describes the criteria for restriction as follows: (A) The inventions must be independent or distinct as claimed; and (B) There must be a serious burden on the examiner if restriction is required. MPEP § 803 (7th ed. 1998) (citations omitted).

Furthermore, the MPEP requires that "Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases." MPEP § 803 (7th ed. 1998). Indeed, an Examiner must clearly provide reasons and/or examples to support how the Groups define inventions that are independent or distinct, and further to show how there is a serious burden on the Examiner. The present Office Action provides some reasoning as to how Groups I and II define inventions that are independent or distinct, but provides no reasoning or examples to show how there is a serious burden on the Examiner. Since the inventions of Group II are related to the invention of Group I, Applicants submit that there is no serious burden on the Examiner. Furthermore, if the invention of Group I is patentable, then the inventions of Group II should similarly be patentable since they are related to the invention of Group I.

Based on the above remarks, reconsideration and withdrawal of the restriction requirement is respectfully requested. If, upon reconsideration, this restriction requirement is made final, Applicants respectfully request the next Office Action contain Form Paragraph 8.05 as suggested in MPEP § 821.01 (7th ed. 1998), to show that Applicants have traversed the requirement and have retained the right to petition from the requirement under 37 C.F.R. § 1.144.

103(a) Rejections

It is basic patent law that the rejections of the present invention under 35 USC §103 must comport with the classic standard set forth in *Graham v. John Deere Company* 383 US 1, 148 USPQ 459 (1966), codified in MPEP Section 706. The Supreme Court's guidance in that landmark case, requires that, to establish a *prima facie* case of obviousness, the USPTO must:

(1) Set forth the differences in the claims over the applied references;

(2) Set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and

(3) Explain why the proposed modification would have been obvious.

To satisfy Step (3), the Patent Office must identify where the prior art provides a motivating suggestion to make the modification proposed in Step (2). See *In re Jones*, 958 F2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992). The mere fact that the prior art may be modified as suggested by the Patent Office does not make the modification obvious unless the prior art suggests the desirability of the modification. See *In re Fritch* 922 F2d 1260, 23 USPQ 2d 1780 (Fed. Cir.1992).

Claims 1-8, 10-29, 33-35, 41, and 42 are rejected by the Examiner under 35 USC 103(a) as allegedly defining obvious subject matter over Feng (US 5,929,007) (hereinafter "'007") in view of Trinh (U.S. Patent No. 6,194,362) (hereinafter "'362").

As described on pages 5-8 of the Office Action, dated June 19, 2003, the examiner asserts that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a cleaning composition containing a solvent, an odor masking perfume, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success due to the broad teachings of '007 in combination with the cleaning composition of '362. The examiner asserts that the broad teachings of this combination would encompass compositions having the same physical parameters as recited by the instant claims. The Applicants respectfully disagree.

Claims 1 and 8, as amended, are commonly directed to a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5. Claims 2-7, 10-29, 33-35, and 41-42 also depend or ultimately depend upon Claim 1, as amended.

Though '007 teach an alkaline aqueous hard surface cleaning composition which exhibit good cleaning efficacy against hardened dried or baked on greasy soil deposits, they do not teach cleaning of cooked-, baked- or burnt-on "acidic" soils. On the other hand, the Applicants invention is directed to a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils with the requirement that the compositions comprise a reserve alkalinity of less than about 5.

According to the Applicants, a reserve of alkalinity is needed and desirable in order to maintain a high pH (see page 4, lines 3-5) in the presence of acidic soils.

In addition, it would be imprudent to assume that the '007 reference encompasses the reserve alkalinity as claimed by the Applicants by a theory of inherency. In order for a reference to be anticipatory upon a theory of inherency under an obviousness rejection, the limitation must necessarily flow from the teachings of a single reference. *See, e.g., In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) ("If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is 'inherent' in its disclosure. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' ... 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' "); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f 1990) ("In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.") (emphasis added). As discussed hereinbefore, '007

The '007 reference simply teaches a pH of at least 12.5 (see col. 6, lines 54-59). Unlike Claims 1 and 8, as amended, in the Applicants' invention, the '007 composition is not formulated to optimize cleaning performance for cooked-, baked- or burnt-on "acidic" soils. Since the '007 reference does not teach the presence of acidic soils, a reserve alkalinity in the presence of such an acid, nor set a limit on such an alkalinity reserve to ensure gentleness to the skin in the manner that the Applicants' invention, it cannot be construed that a reserve alkalinity "*necessarily*" flows from the teachings of '007, as required by *In re Robertson*.

The '362 reference is directed to glass cleaning compositions and not to hard surface cleaners useful in removing cooked-, baked- or burnt-on "acidic" soils. Both '007 and '362 are silent as to the problem of the removal of cooked-on or backed-on acidic soils. Hence, both references do not teach the need to maintain a reserve alkalinity in the presence of an acid. Unlike the Applicants who teach that the reserve alkalinity should not be so high as to risk damaging the skin of the user (see page 4, lines 4-6), the cited references teach no such precaution.

Thus, since both references neither teach or suggest a detergent composition for cooked-, baked- or burnt-on "acidic" soils having a reserve alkalinity of less than 5, the '362 reference can add nothing to support the examiner's assertions in combination with '007. Therefore, the '007 reference alone or in combination with the '362 reference does not support an obviousness rejection.

It is submitted that the references, alone or in combination, do not teach or suggest every element of the claims – to wit, a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5. Accordingly, the reference does not render Claims 1 and 8, as amended, obvious under §103. MPEP 2143.03 and in re Royka, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974). *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants also respectfully submit that Claims 2-7, 9-10, 12-35, and 41-42 which ultimately depend from Claim 1, as amended, are also not rendered obvious. In light of the foregoing remarks, it is submitted that all claims are in condition for allowance. Reconsideration and withdrawal of the rejection is requested.

Claim 30 is rejected by the Examiner under 35 USC 103(a) as allegedly defining obvious subject matter over '007 in view of '362 as applied to Claims 1-8, 10-29, 33-35, 41, and 42 above, and further in view of Ofosu-Asante (U.S. Pat. No. 5,739,092) (hereinafter "'092").

The examiner asserts that the broad teachings of this combination would encompass compositions having the same physical parameters as recited by the instant claim. The Applicants respectfully disagree.

Claim 30 is directed to a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5, and a salt having a divalent cation. Claim 30 is dependant upon Claim 1, as amended. As described above, both '007 and '362 are silent as to the problem of the removal of cooked-on or backed-on acidic soils. Hence, both references do not teach or suggest the need to maintain a reserve alkalinity in the presence of an acid.

The '092 reference is directed to a liquid or gel dishwashing detergent having good grease removal benefits. However, there is no teaching or suggestion in '092 that its detergent composition is used for removing cooked-, baked- or burnt-on acidic soils. Like '007 and '362, '092 is also silent on the need for a reserve alkalinity in the presence of an acid. Furthermore, the '092 reference does not teach or suggest a need to set a limit on such a reserve alkalinity to ensure gentleness to the skin. Since the '092 reference does not teach or suggest the need for a reserve alkalinity in the presence of acid, nor set a limit on such an alkalinity reserve in the manner that the Applicants' invention, it cannot be construed that a reserve alkalinity "*necessarily*" flows from the teachings of '092, as required by *In re Robertson*.

For the reasons stated above, it is again submitted that the references, alone or in combination, do not teach or suggest every element of the claims – to wit, a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5. Accordingly, the reference does not render Claim

30 obvious under §103. MPEP 2143.03 and in re Royka, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974). *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully submit that Claim 30, which depends from Claim 1, as amended, is not rendered obvious. In light of the foregoing remarks, it is submitted that Claim 30 is in condition for allowance. Reconsideration and withdrawal of the rejection is requested.

Claims 31 and 32 are rejected by the Examiner under 35 USC 103(a) as allegedly defining obvious subject matter over '007 in view of '362 as applied to Claims 1-8, 10-29, 33-35, 41, and 42 above, and further in view of JP 8151597 (hereinafter "597").

The examiner asserts that the broad teachings of this combination would encompass compositions having the same physical parameters as recited by the instant claims. The Applicants respectfully disagree.

Claims 31 and 32 are directed to a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5, and depend or ultimately depend upon Claim 1, as amended. Claim 31 additionally comprises a thickening system comprising synthetic smectite type clay thickening agent having an average platelet size of less than about 100 nm. According to Claim 32, the thickening system comprises a mixture of a synthetic smectite type clay-thickening agent having an average platelet size of less than about 100 nm and a natural gum.

As described above, both '007 and '362 are silent as to the problem of the removal of cooked-on or backed-on acidic soils. Hence, both references do not teach or suggest the need to maintain a reserve alkalinity in the presence of an acid.

The '597 reference is directed to a liquid detergent composition, having a favorable viscosity and good liquidity without causing the stringiness, etc., in taking out thereof from a container in use by blending a clay mineral having specific properties. There is no teaching or suggestion in '597 that its detergent composition is used for removing cooked-, baked- or burnt-on acidic soils. Like '007 and '362, '597 is also silent on the need for a reserve alkalinity in the presence of an acid. In addition, the '597 reference does not teach or suggest a need to set a limit on such a reserve alkalinity to ensure gentleness to the skin. Since the '597 reference does not teach or suggest the need for a reserve alkalinity in the presence of acid, nor set a limit on such an alkalinity reserve in the manner that the Applicants' invention, it cannot be construed that a reserve alkalinity "*necessarily*" flows from the teachings of '597, as required by *In re Robertson*.

For the reasons stated above, it is again submitted that the references, alone or in combination, do not teach or suggest every element of the claims– to wit, a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition

comprises a reserve alkalinity of less than about 5. Accordingly, the reference does not render Claims 31 and 32 obvious under §103. MPEP 2143.03 and in re Royka, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974). *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully submit that Claims 31 and 32, which ultimately depend from Claim 1, as amended, are not rendered obvious. In light of the foregoing remarks, it is submitted that Claims 31 and 32 are in condition for allowance. Reconsideration and withdrawal of the rejection is requested.

Claims 1-8, 10-29, 33-35, 41-44 are rejected by the Examiner under 35 USC 103(a) as allegedly defining obvious subject matter over '362.

The examiner asserts that the broad teachings of this combination would encompass compositions having the same physical parameters as recited by the instant claims. The Applicants respectfully disagree.

Claims 1, 8, 43 and 44 are either commonly directed to or refer to a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5. Claims 2-7, 10-29, 33-35, and 41-42 ultimately depend upon Claim 1, as amended.

As described above, '362 is silent as to the problem of the removal of cooked-on or backed-on acidic soils. Hence, '362 does not teach the need to maintain a reserve alkalinity in the presence of an acid.

For the reasons stated above, it is again submitted that the reference does not teach or suggest every element of the claims – to wit, a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5. Accordingly, the reference does not render Claims 1-8, 10-29, 33-35, and 41-44 obvious under §103. MPEP 2143.03 and in re Royka, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974). *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully submit that Claims 1-8, 10-29, 33-35, 41-42, which ultimately depend from Claim 1, as amended, or Claims 43 and 44, as amended, are not rendered obvious. In light of the foregoing remarks, it is submitted that Claims 1-8, 10-29, 33-35, 41-44 are in condition for allowance. Reconsideration and withdrawal of the rejection is requested.

Claim 9 are rejected by the Examiner under 35 USC 103(a) as allegedly defining obvious subject matter over '362 or '362 as applied to the rejected claims above, and further in view of Trinh et al (U.S. Pat. No. 6,001,789) (hereinafter "789")

The examiner asserts that the broad teachings of this combination would encompass compositions having the same physical parameters as recited by the instant claims. The Applicants respectfully disagree.

Claim 9 is directed to a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5, and a cyclodextrin malodor-control agent.

As described above, '362 is silent as to the problem of the removal of cooked-on or backed-on acidic soils. Hence, '362 does not teach the need to maintain a reserve alkalinity in the presence of an acid. Like '362, '789 is also silent on the need for a reserve alkalinity in the presence of an acid. Furthermore, the '789 reference does not teach or suggest a need to set a limit on such a reserve alkalinity to ensure gentleness to the skin. Since neither '362 not '789 references teach or suggest the need for a reserve alkalinity in the presence of acid, nor set a limit on such an alkalinity reserve in the manner that the Applicants' invention, it cannot be construed that a reserve alkalinity *"necessarily"* flows from the teachings of '362 or '789, as required by *In re Robertson*.

Finally, it is again submitted that the references, alone or in combination, do not teach or suggest every element of the claims – to wit, a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5. Accordingly, the reference does not render Claim 9 obvious under §103. MPEP 2143.03 and in re Royka, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974). *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully submit that Claim 9, which depends from Claim 1, as amended, is not rendered obvious. In light of the foregoing remarks, it is submitted that Claim 9 is in condition for allowance. Reconsideration and withdrawal of the rejection is requested.

Double Patenting Rejection

Claims 1-35 and 41-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over Claim 37-42 of 09/909403 and Claims 87-91 of 09/909288. Claims 1, 8, 43, and 44, as amended, should obviate this double patenting rejection as neither application requires a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5. However, should the conflicting claims eventually become patented, and the examiner still requires such action, the Applicants will submit a terminal disclaimer in compliance with 37 CFR 1.321(c).

CONCLUSION

In view of the foregoing remarks, reconsideration of the application, withdrawal of the restriction requirement, and allowance of all claims are respectfully requested.

Respectfully submitted,

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